

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	:	Before the Examiner:
Chan et al.	:	Ahmed, Affaf
	:	
Serial No.: 10/753,204	:	Group Art Unit: 3622
	:	
Filing Date: January 7, 2004	:	
	:	
Title: METHOD FOR	:	IBM Corporation
PRESENTING PERSONALIZED	:	Dept. T81/Bldg. 503
CONTENT ON ELECTRONIC	:	P.O. Box 12915
COMMERCE WEB PAGES	:	3039 Cornwallis Road
	:	Research Triangle Park, NC 27709

APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I. REAL PARTY IN INTEREST

The real party in interest is International Business Machines Corporation, which is the assignee of the entire right, title and interest in the above-identified patent application.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants, Appellants' legal representative or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 13-20 are pending in the Application. Claims 1-12 were cancelled. Claims 13-20 stand rejected. Claims 13-20 are appealed.

IV. STATUS OF AMENDMENTS

Appellants have not submitted any amendments following receipt of the final office action with a mailing date of September 30, 2008.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claim 13:

In one embodiment of the present invention, a computer-implemented method for providing web-based electronic commerce personalized marketing content to a user comprises the step of defining a personalized web page comprising one or more links to initial product exploration or guided search web pages. Specification, page 11, lines 7-16. The links being based on personalization information for the user, where the exploration web pages permit a customer to reach pages of interest by identifying product attributes. Specification, page 11, lines 18-19. The guided search web pages permit the customer to reach pages of interest by prompting the customer for answers about characteristics and preferences of the customer. Specification, page 11, lines 20-21. The method additionally comprises defining the one or more initial product exploration or guided search web pages, each initial product exploration or guided search web page being determined based on personalization information for the user. Specification, page 11, lines 21-24. Further, the method comprises each initial product exploration web page comprising an entry point to a set of exploration web pages defined according to product exploration metaphor technology and the set of the exploration web pages being defined with reference to personalization information for the user. Specification, page 11, lines 21-24; Specification, page 12, lines 17-19. Additionally, the method comprises each initial guided search web page comprising an entry point to a set of guided search web pages defined according to guided search technology and the set of the guided search web pages being defined with reference to personalization information for the user. Specification, page 11, lines 21-24; Specification, page 19, lines 2-6, 12-14, 18-22; Specification, page 20, lines 15-18. In addition, the method comprises providing the defined web pages to the user for display in response to requests from the user. Specification, page 11,

lines 25-28.

Independent Claim 19:

In one embodiment of the present invention, a method for delivering marketing content to a user comprises generating a web page comprising a set of links based on personalization information from the user. Specification, page 10, lines 15-17; Specification, page 11, lines 7-9. The method additionally comprises receiving a selection of one of the set of links. Specification, page 11, lines 9-13. Furthermore, the method comprises generating an exploration web page based on the selected one of the set of links, where the exploration web page comprises a set of product attributes based on personalization information from the user. Specification, page 11, lines 11-13; Specification, page 12, lines 7-12, 20-21; Specification, page 15, lines 13-18. In addition, the method comprises receiving a selection of one or more product attributes from the set of product attributes that are of interest to the user. Specification, page 17, lines 4-7.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

- A. Claim 13 stands rejected under 35 U.S.C. §112, second paragraph.
- B. Claims 19 and 20 stand rejected under 35 U.S.C. §102(b) as being anticipated by Smith et al. (U.S. Patent Application Publication No. 2002/0010625) (hereinafter "Smith").
- C. Claims 13-18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Jacobi et al. (U.S. Patent No. 7,113,917) (hereinafter "Jacobi") in view of Smith.

VII. ARGUMENT

- A. Claim 13 is not properly rejected under 35 U.S.C. §112, second paragraph.

The Examiner has rejected claim 13 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject

matter which Appellants regard as the invention. Office Action (9/30/2008), page 6. In particular, the Examiner rejects claim 13 under 35 U.S.C. §112, second paragraph, because it is allegedly unclear as to whether a user is prompted to enter a preference about the user's profile or is prompted to enter a preference about the product. *Id.*

Claim 13 specifically states that the guided search web pages feature permits the customer to reach pages of interest by prompting the customer for answers about the characteristics and preferences of the customer. Hence, the customer is prompted for answers about the preferences of the customer and not prompted to enter preferences about the product.

As a result, claim 13 clearly sets forth the metes and bounds of the patent protection desired. The Examiner has not provided any evidence that a person of ordinary skill in the art would not be able to determine the scope of the claimed subject matter in claim 13. One having ordinary skill in the art can determine the scope of the claimed subject matter in claim 13. A rejection under 35 U.S.C. §112, second paragraph, is not appropriate, when the scope of the claimed subject matter can be determined by one having ordinary skill in the art. M.P.E.P. §2173. Consequently, Appellants respectfully assert that claim 13 is allowable under 35 U.S.C. §112, second paragraph.

B Claims 19 and 20 are not properly rejected under 35 U.S.C. §102(b) as being anticipated by Smith.

The Examiner has rejected claims 19 and 20 under 35 U.S.C. §102(b) as being anticipated by Smith. Office Action (9/30/2008), page 10. Appellants respectfully traverse these rejections for at least the reasons stated below.

For a claim to be anticipated under 35 U.S.C. §102, each and every claim limitation must be found within the cited prior art reference and arranged as required by the claim. M.P.E.P. §2131.

1. Claim 19 is not anticipated by Smith.

The Examiner cites paragraphs [0048 and 0206] and Figure 12 of Smith as

disclosing "generating an exploration web page based on said selected one of said set of links, wherein said exploration web page comprises a set of product attributes based on personalization information from said user" as recited in claim 19. Office Action (5/13/2008), page 5; Office Action (9/30/2008), page 10. Appellants respectfully traverse.

The Examiner cited to Figure 11 of Smith as disclosing a web page comprising a set of links based on personalization information from the user. Office Action (5/13/2008), page 5. As illustrated in Figure 11, a web page includes a list of recently viewed items 402, a list of recommended items 404 and a list of top selling items 406. As understood by Appellants, the Examiner asserts that the list of recommended items 404 discloses the set of links based on personalization information from the user.

Smith discloses that table 60 contains data that reflects the collective interests of the community of users. [0078]. Smith further discloses that the table 60 may be used to display "canned" lists of related items on product detail pages of the "popular" items. [0206]. Smith further discloses that Figure 12 illustrates this feature in example form. [0206].

Hence, Figure 12 of Smith discloses using table 60 of Smith to display "canned" lists of related items on product detail pages of the "popular" items.

There is no language in Smith that discloses generating an exploration web page based on the selected one of the set of links, where the exploration web page comprises a set of product attributes based on personalization information from the user. Instead, Smith disclose that Figure 12 illustrates the detail page of a particular product. Smith does disclose that the detail page may include information about the product. [0048]. However, the web page does not include a set of product attributes based on personalization information from the user. In other words, the information about the product is not displayed in Smith based on personalization information from the user.

Thus, Smith does not disclose all of the limitations of claim 19, and thus Smith does not anticipate claim 19. M.P.E.P. §2131.

In response to Appellants' above arguments, the Examiner additionally cites paragraphs [0021, 0047 and 0048] of Smith as disclosing the above-cited claim limitation. Office Action (9/30/2008), pages 2-3. Appellants respectfully traverse.

Smith discloses that the recommendations are generated by monitoring the products viewed by the user during the current browsing session, and using these as the "items of known interest." [0021]. Smith further discloses that the resulting list of recommended items (products) is presented to the user during the same browsing session. [0021]. Furthermore, Smith discloses that the merchant website includes functionality for allowing users to search, browse, and make purchases from an online catalog of purchasable items or "products," such as book titles, music titles, video titles, toys, and electronics products. [0047]. Additionally, Smith discloses that detailed information about each product can be obtained by accessing that product's detail page, where a "detail page" is a page that predominantly contains information about a particular product or other item. [0048]. Further, Smith discloses that each product detail page typically includes a description, picture, and price of the product, customer reviews of the product, lists of related products, and information about the product's availability. [0048]. In addition, Smith discloses that the site is preferably arranged such that, in order to access the detail page of a product, a user ordinarily must either select a link associated with that product (e.g., from a browse node page or search results page) or submit a search query uniquely identifying the product. [0048].

Hence, Smith discloses that recommendations are generated by monitoring the products viewed by the user during the current browsing session. Further, Smith discloses that each product can be obtained by accessing that product's detail page, where a "detail page" is a page that predominantly contains information about a particular product or other item. Additionally, Smith discloses that each product

detail page typically includes a description, picture, and price of the product, customer reviews of the product, lists of related products, and information about the product's availability.

There is no language in the cited passages that discloses generating an exploration web page based on the selected one of the set of links, where the exploration web page comprises a set of product attributes based on personalization information from the user. Instead, Smith discloses a detail page of a particular product. Smith does disclose that the detail page may include information about the product. [0048]. However, the web page does not include a set of product attributes based on personalization information from the user. In other words, the information about the product is not displayed in Smith based on personalization information from the user.

The Examiner further cites paragraphs [0048 and 0206] and Figure 12 of Smith as disclosing "receiving a selection of one or more product attributes from said set of product attributes that are of interest to said user" as recited in claim 19. Office Action (5/13/2008), page 5; Office Action (9/30/2008), page 10. Appellants respectfully traverse.

As stated above, Smith instead discloses using table 60 of Smith to display "canned" lists of related items on product detail pages of the "popular" items. Smith further discloses that Figure 12 illustrates the detail page of a particular product.

There is no language in the cited passages or depiction in Figure 12 that discloses receiving a selection of one or more product attributes. Neither is there any language in the cited passages or depiction in Figure 12 that discloses receiving a selection of one or more product attributes that are of interest to the user. Thus, Smith does not disclose all of the limitations of claim 19, and thus Smith does not anticipate claim 19. M.P.E.P. §2131.

In response to Appellants' above arguments, the Examiner additionally cites paragraphs [0021, 0047 and 0048] of Smith as disclosing the above-cited claim

limitation. Office Action (9/30/2008), pages 2-3.

As stated above, Smith discloses that recommendations are generated by monitoring the products viewed by the user during the current browsing session. Further, Smith discloses that each product can be obtained by accessing that product's detail page, where a "detail page" is a page that predominantly contains information about a particular product or other item. Additionally, Smith discloses that each product detail page typically includes a description, picture, and price of the product, customer reviews of the product, lists of related products, and information about the product's availability.

There is no language in the cited passages that discloses receiving a selection of one or more product attributes. Instead, Smith discloses a product detail page that may include product attributes. However, Smith does not disclose receiving a selection of one of these product attributes. Neither is there any language in the cited passages that discloses receiving a selection of one or more product attributes that are of interest to the user. Thus, Smith does not disclose all of the limitations of claim 19, and thus Smith does not anticipate claim 19. M.P.E.P. §2131.

2. Claim 20 is not anticipated by Smith for at least the reasons that claim 19 is not anticipated by Smith.

Claim 20 recites the combinations of features of independent claim 19, and hence claim 20 is not anticipated by Smith for at least the above-stated reasons that claim 19 is not anticipated by Smith.

3. Claim 20 is not anticipated by Smith.

The Examiner cites paragraphs [0047, 0048 and 0206] as well as Figure 12 of Smith as disclosing "generating a results web page in response to receiving said indication from said user to show products, wherein said results web page comprises a product list having information and one or more links to product web pages for products that meet a criteria based on said selection of one or more product attributes" as recited in claim 20. Office Action (5/13/2008), page 5; Office Action (9/30/2008),

page 10. Appellants respectfully traverse.

As stated above, Smith instead discloses using table 60 of Smith to display "canned" lists of related items on product detail pages of the "popular" items. Smith further discloses that Figure 12 illustrates the detail page of a particular product.

There is no language in the cited passages or depiction in Figure 12 that discloses generating a results web page in response to receiving an indication from the user to show products, where the results web page comprises a product list having information and one or more links to product web pages for products that meet a criteria based on the selection of one or more product attributes. Instead, Figure 12 depicts a detail page of a particular product that includes a hypertextual list 500 of related items. The hypertextual list 500 of related items do not contain links to web pages for products that meet a criteria based on the selection of one or more product attributes. There was no selection of product attributes that were of interest to the user. Thus, Smith does not disclose all of the limitations of claim 20, and thus Smith does not anticipate claim 20. M.P.E.P. §2131.

In response to Appellants' above arguments, the Examiner cites paragraphs [0201-0203] and Figure 12 of Smith as disclosing the above-cited claim limitations. Office Action (9/30/2008), page 3. Appellants respectfully traverse.

Smith instead discloses that the customized web page preferably includes a hypertextual list 402 of recently viewed items (and more specifically, products whose detail pages were visited in during the current session). [0201]. Smith additionally discloses that as an example, as the user browses the site, a persistent link may be displayed which reads "view a list of the products you've recently viewed." [0201]. Furthermore, Smith discloses that each hyperlink within the list 402 is to a product detail page visited during the current browsing session. [0202]. Additionally, Smith discloses that the list of recently viewed items may include detail pages viewed during prior sessions (e.g., all sessions over last three days), and may include links to recently accessed browse node pages and/or recently used search queries. [0202]. In

addition, Smith discloses that a filtered version of a user's product viewing history may be displayed in certain circumstances. [0203]. Furthermore, Smith discloses that as an example, when a user views a product detail page of an item in a particular product category, this detail page may be supplemented with a list of (or a link to a list of) other products recently viewed by the user that fall within the same product category. [0203].

Hence, Smith discloses a list of recently viewed items, where each item in the list is a hyperlink to a product detail page. Further, Smith discloses that when a user views a product detail page of an item in a particular product category, the detail page may further include a list or a link to a list of other products recently viewed by the user that fall within the same product category.

There is no language in the cited passages or depiction in Figure 12 that discloses generating a results web page in response to receiving an indication from the user to show products, where the results web page comprises a product list having information and one or more links to product web pages for products that meet a criteria based on the selection of one or more product attributes. Instead, Smith discloses a detail page of a particular product that may include a list or a link to a list of other products recently viewed by the user that fall within the same product category. There is no selection of a product attribute. A "product attribute" refers to an attribute of the product, such as "size" where "size" may have the value of "compact," "mid-size" and "luxury" for a product attribute for a product family of vehicles or may have the value of "small," "medium" and "large" for a product attribute for a product family of clothing. See, e.g., Appellants' Specification, page 14, lines 13-18. Appellants' Specification includes other examples of product attributes such as product attribute elements 24 and 26 being used to define a 2-door sedan with a cost above \$50,000 for an automobile example. See, e.g., Appellants' Specification, page 17, lines 17-18. Smith does not disclose a web page including a product list having information and one or more links to product web pages for products that meet a criteria based on the selection of product attributes. There was

no selection of product attributes that were of interest to the user. Thus, Smith does not disclose all of the limitations of claim 20, and thus Smith does not anticipate claim 20. M.P.E.P. §2131.

C. Claims 13-18 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Jacobi in view of Smith.

1. Jacobi and Smith, taken singly or in combination, do not teach at least the following claim limitations.

a. Claim 13 is patentable over Jacobi in view of Smith.

The Examiner cites column 3, lines 13-34 and column 7, lines 61-67 of Jacobi as teaching "wherein said guided search web pages permit said customer to reach pages of interest by prompting said customer for answers about characteristics and preferences of said customer" as recited in claim 13. Office Action (9/30/2008), page 7. Appellants respectfully traverse.

Jacobi teaches that the BookMatcher application 50 uses the users' item ratings profiles to generate personal recommendations, which can be requested by the user by selecting an appropriate hyperlink. Column 7, lines 61-65. Furthermore, Jacobi teaches that the item ratings profiles are also used by an "Instant Recommendations" implementation of the Recommendation Service. Column 7, lines 65-67.

Hence, Jacobi teaches using the users' item ratings profiles to generate personal recommendations.

There is no language in the cited passages that teaches guided search web pages. Neither is there any language in the cited passages that teaches guided search web pages that permit the customer to reach pages of interest by prompting the customer for answers about characteristics and preferences of the customer. The Examiner has not cited to any passage in Jacobi that teaches guided search web pages that permit the customer to reach pages of interest by prompting the customer for answers about characteristics and preferences of the customer.

Therefore, the Examiner's cited passages do not teach the above-cited claim limitation as asserted by the Examiner.

The Examiner further cites paragraphs [0021, 0047 and 0048] of Smith as teaching "wherein said exploration web pages permit a customer to reach pages of interest by identifying product attributes" as recited in claim 13. Office Action (9/30/2008), page 7. Appellants respectfully traverse.

Smith instead teaches that the recommendations are generated by monitoring the products viewed by the user during the current browsing session, and using these as the "items of known interest." [0021]. Smith further teaches that the resulting list of recommended items (products) is presented to the user during the same browsing session. [0021]. Furthermore, Smith teaches that the merchant website includes functionality for allowing users to search, browse, and make purchases from an online catalog of purchasable items or "products," such as book titles, music titles, video titles, toys, and electronics products. [0047]. Additionally, Smith teaches that detailed information about each product can be obtained by accessing that product's detail page, where a "detail page" is a page that predominantly contains information about a particular product or other item. [0048]. Further, Smith teaches that each product detail page typically includes a description, picture, and price of the product, customer reviews of the product, lists of related products, and information about the product's availability. [0048]. In addition, Smith teaches that the site is preferably arranged such that, in order to access the detail page of a product, a user ordinarily must either select a link associated with that product (e.g., from a browse node page or search results page) or submit a search query uniquely identifying the product. [0048].

Hence, Smith teaches that recommendations are generated by monitoring the products viewed by the user during the current browsing session. Further, Smith teaches that each product can be obtained by accessing that product's detail page, where a "detail page" is a page that predominantly contains information about a

particular product or other item. Additionally, Smith teaches that each product detail page typically includes a description, picture, and price of the product, customer reviews of the product, lists of related products, and information about the product's availability.

There is no language in the cited passages that teaches exploration web pages permitting a customer to reach pages of interest by identifying product attributes. Smith does not teach permitting a customer to identify product attributes. As discussed above, a "product attribute" refers to an attribute of the product, such as "size" where "size" may have the value of "compact," "mid-size" and "luxury" for a product attribute for a product family of vehicles or may have the value of "small," "medium" and "large" for a product attribute for a product family of clothing. See, e.g., Appellants' Specification, page 14, lines 13-18. The customer does not identify product attributes in Smith.

Therefore, the Examiner's cited passages do not teach the above-cited claim limitation as asserted by the Examiner.

b. Claim 13 does not include optional language.

The Examiner asserts that "defining a personalized web page comprising one or more links to initial product exploration or guided search web pages" as recited in claim 13 is optional language and does not limit the scope of the claim limitation. Office Action (9/30/2008), page 8. Appellants respectfully traverse.

M.P.E.P. §2106 II C states that language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. However, claim 13 clearly require steps to be performed in connection with the phrase "defining a personalized web page comprising one or more links to initial product exploration or guided search web pages." While the claim language includes an "or," that does not imply that a step is not required to be performed. The personalized web page must be defined to include links to either the initial product exploration or the guided search

web pages. Since the recited claim limitation requires a step to be performed, the recited claim limitation limits the scope of claim 13.

- c. Claims 14-18 are patentable over Jacobi in view of Smith at least the reasons that claim 13 is patentable over Jacobi in view of Smith.

Claims 14-18 recite the combinations of features of independent claim 13, and hence claims 14-18 are patentable over Jacobi in view of Smith for at least the above-stated reasons that claim 13 is patentable over Jacobi in view of Smith.

- d. Claim 18 is patentable over Jacobi in view of Smith.

The Examiner cites paragraphs [0182-0189] of Smith as teaching "in which the set of guided search web pages comprises web pages corresponding to a subset of potential guided search nodes in a guided search tree, the subset being defined with reference to the personalization information for the user" as recited in claim 18. Office Action (5/13/2008), page 4. Appellants respectfully traverse.

Smith instead teaches that each time a user views a product detail page, the web server 32 notifies the HTTP/XML application 37, causing the HTTP/XML application to record the event in real time in a session-specific record of the click stream table. [0182]. Smith further teaches that once the user has viewed a threshold number of product detail pages during the current session, the user is presented with a link to a custom page as shown in Figure 11. [0184]. Additionally, Smith teaches that a session recommendations component 52 accesses the user's cached session record to identify the products the user has viewed, and then uses some or all of these products as the "items of known interest" for generating the personal recommendations, as shown in Figure 11. [0184].

Hence, Smith teaches an HTTP/XML application recording each time a user views a product detail page. Smith further teaches generating a list of recommendations based on the user's cached session record which identifies the products the user has viewed.

There is no language in the cited passages that teaches a set of guided search web pages. As discussed above, the guided search web pages permit the customer to reach pages of interest by prompting the customer for answers about characteristics and preferences of the customer. Neither is there any language in the cited passages that teaches a set of guided search web pages that comprises web pages corresponding to a subset of potential guided search nodes in a guided search tree. Neither is there any language in the cited passages that teaches a set of guided search web pages that comprises web pages corresponding to a subset of potential guided search nodes in a guided search tree, the subset being defined with reference to the personalization information for the user.

Therefore, the Examiner's cited passages do not teach the above-cited claim limitations as asserted by the Examiner.

In response to Appellants' above arguments, the Examiner cites paragraphs [0047-0048] of Smith as teaching the above-cited claim limitation. Office Action (9/30/2008), page 5. Appellants respectfully traverse.

As stated above, Smith teaches that the merchant website includes functionality for allowing users to search, browse, and make purchases from an online catalog of purchasable items or "products," such as book titles, music titles, video titles, toys, and electronics products. [0047]. Additionally, Smith teaches that detailed information about each product can be obtained by accessing that product's detail page, where a "detail page" is a page that predominantly contains information about a particular product or other item. [0048]. Further, Smith teaches that each product detail page typically includes a description, picture, and price of the product, customer reviews of the product, lists of related products, and information about the product's availability. [0048]. In addition, Smith teaches that the site is preferably arranged such that, in order to access the detail page of a product, a user ordinarily must either select a link associated with that product (e.g., from a browse node page

or search results page) or submit a search query uniquely identifying the product. [0048].

Hence, Smith teaches that each product can be obtained by accessing that product's detail page, where a "detail page" is a page that predominantly contains information about a particular product or other item. Additionally, Smith teaches that each product detail page typically includes a description, picture, and price of the product, customer reviews of the product, lists of related products, and information about the product's availability.

There is no language in the cited passages that teaches a set of guided search web pages. As discussed above, the guided search web pages permit the customer to reach pages of interest by prompting the customer for answers about characteristics and preferences of the customer. Neither is there any language in the cited passages that teaches a set of guided search web pages that comprises web pages corresponding to a subset of potential guided search nodes in a guided search tree. Neither is there any language in the cited passages that teaches a set of guided search web pages that comprises web pages corresponding to a subset of potential guided search nodes in a guided search tree, the subset being defined with reference to the personalization information for the user.

Therefore, the Examiner's cited passages do not teach the above-cited claim limitations as asserted by the Examiner.

e. Claim 18 does not include optional language.

The Examiner asserts that claim 18 recites an alternative limitation of claim 13 for a guided search and therefore includes optional language and does not limit the scope of the claim limitation. Office Action (9/30/2008), page 5. Appellants respectfully traverse.

M.P.E.P. §2106 II C states that language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular

structure does not limit the scope of a claim or claim limitation. As discussed above, claim 13 clearly require steps to be performed in connection with the phrase "defining a personalized web page comprising one or more links to initial product exploration or guided search web pages." Since the recited claim limitation in claim 13 requires a step to be performed, the recited claim limitation limits the scope of claim 13. Further, the Examiner has not pointed to any language in claim 18 as being optional. Instead, the Examiner's basis for asserting that claim 18 includes optional language is based on the Examiner's belief that claim 13 included optional language. As Appellants have shown, claim 13 does not include optional language. As a result, claim 18 does not recite optional language and includes language limiting the scope of the claim limitation.

2. Examiner's reasoning for modifying Jacobi with Smith to include the missing claim limitation of claim 13 is insufficient to establish a *prima facie* case of obviousness.

In order to establish a *prima facie* case of obviousness, the Examiner must provide articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (cited approvingly in *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007)).

The Examiner admits that Jacobi does not teach "wherein said exploration web pages permit a customer to reach pages of interest by identifying product attributes" as recited in claim 13. Office Action (9/30/2008), page 7. The Examiner asserts that Smith teaches this missing claim limitation. *Id.* The Examiner states that the reasoning for modifying Jacobi with Smith to include the above-cited missing claim limitation is for "providing consumers with options to refine their products need." *Id.* at page 8.

While the Examiner may consider many factors in finding a reason to combine, the Examiner still must explain how the Examiner derived the reasoning for modifying Jacobi to include the above-cited missing claim limitation. *KSR*

International Co. v. Teleflex Inc., 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007). While the limitations of claim 13 may provide consumers with options, there are many other ways to provide consumers with options. Why in particular would one skilled in the art modify Jacobi to specifically have an exploration web page permit a customer to reach pages of interest by identifying product attributes is the question the Examiner must answer. The Examiner must provide a rational underpinning for modifying Jacobi to have an exploration web page permit a customer to reach pages of interest by identifying product attributes. Since the Examiner has not provided such a rational underpinning, the Examiner has not established a *prima facie* case of obviousness in rejecting claims 13-18. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007).

3. Examiner's reasoning for modifying Jacobi with Smith to include the missing claim limitations of claims 14-17 is insufficient to establish a *prima facie* case of obviousness.

As stated above, in order to establish a *prima facie* case of obviousness, the Examiner must provide articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (cited approvingly in *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007)).

The Examiner admits that Jacobi does not teach the limitations of claims 14-17. Office Action (5/13/2008), pages 3-4; Office Action (9/30/2008), pages 8-9. The Examiner asserts that Smith teaches these missing claim limitations of claims 14-17. *Id.* The Examiner states that the reasoning for modifying Jacobi with Smith to include the missing claim limitations of claims 14-17 is for "providing consumers with a variety of personalized options to choose from when exploring web-pages to view and/or purchase products." Office Action (5/13/2008), page 5; Office Action (9/30/2008), page 9.

While the Examiner may consider many factors in finding a reason to combine, the Examiner still must explain how the Examiner derived the reasoning for

modifying Jacobi to include the above-cited missing claim limitations. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007). While the limitations of claims 14-17 may provide consumers with a variety of personalized options, there are many other ways to provide consumers with a variety of personalized options. Why in particular would one skilled in the art modify Jacobi to specifically include the limitations of claims 14-17 is the question the Examiner must answer. For instance, why would one skilled in the art modify Jacobi to include a set of item attributes defined by a personalization system, as recited in claim 14? Why would one skilled in the art modify Jacobi to have each initial product exploration web page comprise a link to a result page, as recited in claim 15? Why would one skilled in the art modify Jacobi to have the result page comprise a result list which comprises an item attribute table in which attributes of a set of items are grouped to permit comparison by a user, as recited in claims 16 and 17?

Since the Examiner has not provided a rational underpinning for modifying Jacobi to include these missing claim limitations, the Examiner has not established a *prima facie* case of obviousness in rejecting claims 14-17. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007).

4. Examiner's reasoning for modifying Jacobi with Smith to include the missing claim limitations of claim 18 is insufficient to establish a *prima facie* case of obviousness.

As stated above, in order to establish a *prima facie* case of obviousness, the Examiner must provide articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (cited approvingly in *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007)).

The Examiner admits that Jacobi does not teach "in which the set of guided search web pages comprises web pages corresponding to a subset of potential guided search nodes in a guided search tree, the subset being defined with reference to the personalization information for the user" as recited in claim 18. Office Action

(5/13/2008), page 4; Office Action (9/30/2008), page 9. The Examiner asserts that Smith teaches these missing claim limitations of claim 18. *Id.* The Examiner states that the reasoning for modifying Jacobi with Smith to include the missing claim limitations of claim 18 is for "providing consumers with a hierarchical tree that is used to guide consumers and that can be systematically searched." Office Action (9/30/2008), page 9.

While the Examiner may consider many factors in finding a reason to combine, the Examiner still must explain how the Examiner derived the reasoning for modifying Jacobi to include the above-cited missing claim limitations. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007).

Further, the Examiner needs to explain the rational connection between the missing claim limitation ("in which the set of guided search web pages comprises web pages corresponding to a subset of potential guided search nodes in a guided search tree, the subset being defined with reference to the personalization information for the user") and the Examiner's reasoning (providing consumers a hierarchical tree that is used to guide consumers and that can be systematically searched). The Examiner has not provided a rational underpinning for modifying Jacobi to include the above-cited claim limitation and therefore has not established a *prima facie* case of obviousness in rejecting claim 18. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007).

VIII. CONCLUSION

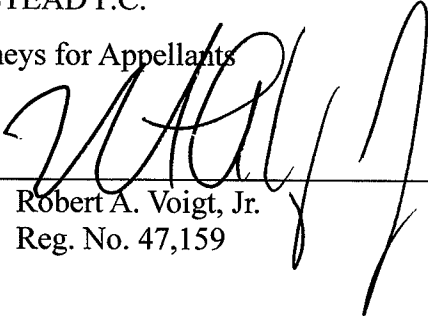
For the reasons noted above, the rejections of claims 13-20 are in error. Appellants respectfully request reversal of the rejections and allowance of claims 13-20.

Respectfully submitted,

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CLAIMS APPENDIX

13. A computer-implemented method for providing web-based electronic commerce personalized marketing content to a user, the method comprising the steps of:

defining a personalized web page comprising one or more links to initial product exploration or guided search web pages, the links being based on personalization information for the user, wherein said exploration web pages permit a customer to reach pages of interest by identifying product attributes, wherein said guided search web pages permit said customer to reach pages of interest by prompting said customer for answers about characteristics and preferences of said customer;

defining the one or more initial product exploration or guided search web pages, each initial product exploration or guided search web page being determined based on personalization information for the user,

each initial product exploration web page comprising an entry point to a set of exploration web pages defined according to product exploration metaphor technology and the set of said exploration web pages being defined with reference to personalization information for the user, and

each initial guided search web page comprising an entry point to a set of guided search web pages defined according to guided search technology and the set of said guided search web pages being defined with reference to personalization information for the user; and

providing the defined web pages to the user for display in response to requests from the user.

14. The method of claim 13 in which the personalization information for the user comprises a set of item attributes defined by a personalization system.

15. The method of claim 14 in which each initial product exploration web page

comprises a link to a result page.

16. The method of claim 15 in which the result page comprises a result list.

17. The method of claim 16 in which the result list comprises an item attribute table in which attributes of a set of items are grouped to permit comparison by a user.

18. The method of claim 14 in which the set of guided search web pages comprises web pages corresponding to a subset of potential guided search nodes in a guided search tree, the subset being defined with reference to the personalization information for the user.

19. A method for delivering marketing content to a user, the method comprising:
generating a web page comprising a set of links based on personalization information from said user;

receiving a selection of one of said set of links;

generating an exploration web page based on said selected one of said set of links, wherein said exploration web page comprises a set of product attributes based on personalization information from said user; and

receiving a selection of one or more product attributes from said set of product attributes that are of interest to said user.

20. The method as recited in claim 19 further comprises:

receiving an indication from said user to show products; and

generating a results web page in response to receiving said indication from said user to show products, wherein said results web page comprises a product list having information and one or more links to product web pages for products that meet a criteria based on said selection of one or more product attributes.

EVIDENCE APPENDIX

No evidence was submitted pursuant to §§1.130, 1.131, or 1.132 of 37 C.F.R. or of any other evidence entered by the Examiner and relied upon by Appellants in the Appeal.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings to the current proceeding.